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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,239	12/20/2005	Claude Juneau	06670/0203474-US0	8830
7278	7590	01/15/2010		
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER GRANO, ERNESTO ARTURIO	
			ART UNIT 3728	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,239	<b>Applicant(s)</b> JUNEAU, CLAUDE	
	<b>Examiner</b> ERNESTO A. GRANO	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt is acknowledged of Applicant's amendment filed on 06/12/2009.
  - Claims 1-21 were canceled.
  - Claims 22-31 were newly added.
  - Claims 22-31 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 22-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
4. MPEP 2164.01 establishes the analysis required to determine whether the filed disclosure contains sufficient information regarding the subject matter of the claims as to one skilled in the art to make and use the claimed invention without undue experimentation. The factors to be considered to determine whether any necessary experimentation is undue, also known as The Wand factors, see *In re Wands*, 858 F. 2d 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) include, but are not limited to:  
(A) The breadth of the claims;

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- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In view of the above factors, it is concluded that the drawings would not enable one of ordinary skill in the art to make the claimed invention. Specifically, in Figures 10 and 12 the reference numbers, such as 60(blunt end), 62(arc), 64(jamb), and other claimed structure are missing. In Figures 11 and 13, the elements are improperly cross sketched. Also, Figures 11 and 13 fail to cooperate with Figures 10 and 12; wherein the blunt end of the tooth is aligned with the tanks outer wall in Figures 10 and 12 and the blunt end of the tooth is aligned with the tanks innermost wall in Figures 11 and 13. During a second interview the applicant indicated that the drawings were labeled incorrectly (elements 60 and 58). It is clear that the guidelines according to the MPEP 608.01 IX were not followed. Therefore, the amount of direction provided by the inventor is not sufficient to allow one of ordinary skill in the art to make the invention without undue experimentation.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitations "a tank" and "the tank" in lines 9-11 of the claim, and it is believed to be in error for -- at least one tank—in each instant.

Claim 28 recites the limitation "said at least one tooth" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

3. In view of the significant rejection under 35 USC 112, 1st paragraph above, the claims could not be compared with the prior art. However, to the extent that the invention could be understood, the search was updated, and the following rejection is made.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22-31 as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebermann (US 4,491,250) in view of Sergio et al. (US 6,364,103).

In re claim 22, Liebermann discloses a container for allowing the release of a first substance into a second substance, said container comprising in combination:

- a can for containing the second substance provided with an opening at its top end and a lateral flexible wall; a support insertable in the can for supporting at least one tank containing the first substance within the can adjacent to the inner surface of the can flexible wall (see Fig.1 of Liebermann); a fastener to fix the support on the can top end (see Fig.9 of Liebermann)

Liebermann discloses the claimed invention as discussed above with the exception of the following claimed limitation that is taught by Sergio et al.:

- a respective tooth having a first end fixed to the support and a second blunt end adjacent to a tank, said tooth second end engaging and perforating a tank in response to a lateral force exerted on an outside area that moves the tooth second end relative to the tank to engage and perforate the tank, thereby releasing a first substance contained within the tank into the second substance contained within the container.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Liebermann in view of Sergio et al. in to allow easy a tooth to penetrate the tank for easy mixing of the two substances as taught by Sergio et al.

Liebermann further disclose:

In re claim 23: the support is made of a material comprising at least one of metal, plastic, paperboard, glass and an alloy of metal.

In re claim 24: the fastener comprises a border at the can top end for cooperating with a superior edge of the can to fix the support on the can close to its opening (see Fig.9 of Liebermann).

In re claim 25: the support comprises two opposite jambs formed as an arc and having an internal surface and an external surface facing the inner surface of the can flexible wall (see Fig.1 of Liebermann).

In re claim 26: said at least one tank is located on the external surface of a jamb (see Fig.1 of Liebermann).

In re claim 27: the jambs forming the arc are flexible to exert a return force on the two jambs towards a home position (see Fig.1 of Liebermann).

In re claim 28 and 31: said at least one tank comprises six tanks; and said at least one tooth comprises six teeth, each one of the teeth being capable of perforating respectively a corresponding one of the tanks.

It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In re claim 29: the support is of a flexible material.

In re claim 30: there is a plurality of tanks on each jamb (see Fig.1 of Liebermann).

### ***Response to Arguments***

6. The Applicant's amendment filed on 06/12/2009, rendered the previous rejection of claims moot. No arguments were made.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERNESTO A. GRANO whose telephone number is 571-270-3927. The examiner can normally be reached on 7:00am - 5:00pm Mon.-Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571-272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ernesto A. Grano/  
Examiner  
Art Unit 3728

EAG

/Ehud Gartenberg/  
Supervisory Patent Examiner, Art Unit 3728